UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,730	06/12/2001	Kenji Nagoya	B422-161	4879

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EXAMINER
GARG, YOGESH C

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 July 2005</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,9,10,12-18,20,21 and 23* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7, 9-10, 12-18, 20-21 and 23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   Applicant's amendment received on 7/26/2005 is acknowledged and entered.

The applicant has currently amended claims 1-7, 9 and 12 and added a new claim 23.

Currently claims 1-7, 9-10, 12-18, 20-21 and 23 are pending for examination.

Response to Arguments

2.1.   Since the applicant has currently amended claim 12, the rejection of claims 12-

18, and 20-21 under 35 U.S.C. §101 and 35 USC 112, second paragraph [submitted in

the previous office action as the claimed invention intended to embrace or overlap two

different statutory classes of invention as set forth in 35 U.S.C. §101] are withdrawn.

However, the currently amended claims 12-18, and 20-21 are further rejected under 35

U.S.C. §101 as being still directed to a non-statutory subject matter.

2.2.   Applicant's arguments filed on 7/26/2005 concerning prior art rejection of claims

1, 12 and 23 (see Remarks, page 8, line 3-page 9, line 7) have been fully considered

but they are not persuasive. The applicant argues, see page 8, lines 14-page 9, line 7,

that Arledge fails to teach or suggest that the wholesaler web server computer 140

serves as a host computer and accordingly it cannot teach or suggest the limitations of

claims 1, 12 and 23. The examiner respectfully disagrees because Arledge explicitly

teaches that the web server computer 140 serves as a host computer (see at least

col.8, lines 47-62, "*The wholesaler web server computer 140 includes sufficient conventional*

hardware and software so as to enable the wholesaler web server computer 140 to "host" an

Internet web site having a unique Internet web address on the World Wide Web and using

conventional protocols, such as http, to communicate therewith. ...."). Since the wholesaler

web server computer 140 serves as a host computer the rest of the teachings as

presented in the previous office action anticipates the applicant's claimed invention. As

earlier submitted, Preparations system "201", see Fig.3 is the creating means for

creating setting information to print data and this print data is recognizable by the other

apparatus, that is "200" the workflow management server computer. The predetermined

process of making print data is disclosed in col.15, line 55-col.16, line 43 on the

instructions of an end-user); and calculating means for calculating a print charge in

accordance with the created setting information, wherein creating the setting information

and calculating the print charge are performed before the printdata is sent to the

network (see at least, Fig.2, and col.17, lines 1-16, where the reference " 241"

corresponds to the calculating means.

 2.3.   The examiner used Official Notice in rejecting claims 10 and 21 under 35

USC 103 (a) as obvious over Arledge in view of Official Notice. The applicant has

neither traversed the facts and benefits of the Official Notice, taken by the examiner,

adequately nor asked for a documentary evidence. Therefore, as per *MPEP-2144.03*

[R-1] C Reliance on Common Knowledge in the Art or "Well Known" Prior Art -, the

common knowledge or well-known fact considered as Official Notice in the art statement

is taken to be admitted prior art and the rejection of claims 10 and 21 is maintained..

In view of the foregoing, this rejection is a Final rejection.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3.1.   Currently amended claims 12-18, 20-21 and 23 are rejected under 35 U.S.C.

§101 because the claimed invention is directed to a non-statutory subject matter.

Claims 12 and 23 are directed to disembodied data structure claim which are per

se not statutory. C.f. In re Wamerdam. The preamble of the independent claim 12 and

all its dependencies, that is claims 13-18 and 20-21 are directed to "a storage medium

storing a program" for use for controlling a computer. The instructions could be in mere

text form on a paper, which can act as a storage medium, and instructions stored on a

paper are not executable by a processor. Also, Data merely stored in a computer

readable medium to be read or outputted by a computer without any functional

interrelationship, and thus do not impart functionality to the computer, i.e., they are not

computer components. Examples of Non-Functional Descriptive Material :Music,

Literature, Art, Photographs, Data base per se are directed to neither a "process" nor a

"machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. Id. at 1551.

The examiner suggests to redraft the claims to store the program/code instructions on a computer readable medium executable by a computer or processor. **A claim to a computer readable medium encoded with functional descriptive material that can function with a computer to effect a practical application that results in a useful, concrete an tangible result (i.e. running an assembly line or executing a stock transaction) satisfies Section 101.** See U.S. Patent 5,710,578 to Beauregard etc. i.e., **a set of instructions in combination with a computer system.** C.f. In re Wamerdam - data structure stored in a computer memory, and In re Lowery, 32 USPQ2d 1031 (Fed. Cir. 1994) - data structure in a computer readable medium. Examples of Statutory Functional Descriptive Material are:

(a) A claimed computer-readable medium encoded with a functional data structure – this defines structural and functional relationships between the data structure and the hardware/software components. See Wamerdam.

(b) A claimed computer-readable medium encoded with a computer program - this defines structural and functional relationships between the computer program and the computer itself which allows the program's functionality to be realized provided that a useful, concrete and tangible result is realized. See U.S. Patent 5,710,578 to Beauregard et al.

Examples of Non-Functional Descriptive Material

■Music

■Literature

■Art

■Photographs

■Data base per se

These are merely stored to be read or outputted by a computer without any functional

interrelationship, and thus do not impart functionality to the computer, i.e., they are not

computer components.

Examples of Non-Functional Descriptive Material per se
Sample Claim 1

A warranty comprising: a first section describing what is covered by the warranty;

A second section describing what is not covered by the warranty.

A warranty is just descriptive material per se. The same applies for claim

language such as "A contract comprising...", and "An invoice produced by a computer,

the invoice comprising..." The claimed invention taken as a whole does not produce a

useful, concrete and tangible result.

Examples of Non-Functional Descriptive Material
Sample Claim 2

A data structure encoded on a computer readable medium comprising:

A first field having data of the age of a customer; a second field having data

describing the products the customer buys; and a third field having a numeric value

indicating the likelihood that the customer would buy similar products.

This is simply a data file – no functional change occurs when an application

program uses the structural data. See In re Lowery.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7, 9-10, 12-18, 20-21 and 23 are rejected under 35 U.S.C. 112, first

paragraph, as failing to comply with the written description requirement. The claim(s)

contains subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

application was filed, had possession of the claimed invention. In the currently

amended claims 1 and 12 and the newly added claim the applicant has included the

limitation, " a print instruction by an operator of the information processing apparatus" ,

which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention. As best understood by the examiner in line

with the applicant's disclosure the creating unit creates setting information in

accordance with a print instruction from a user. The specification does not disclose

explicitly that this user is operating the information processing apparatus which is a host

computer. Therefore, keeping in line with the applicant's disclosure claims 1-7, 9-10, 12-

18, 20-21 and 23 will be treated further on merits based upon the interpretation that

creating unit creates setting information in accordance with a print instruction from a

user.

Specification

6.   The amendment filed on 7/26/2005 is objected to under 35 U.S.C. 132(a)

because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no

amendment shall introduce new matter into the disclosure of the invention. The added

material which is not supported by the original disclosure is as follows: " a print

instruction by an operator of the information processing apparatus and wherein the

information processing apparatus serves as a host computer" in claims 1, 12 and 23.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 102

7   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2)
of such treaty in the English language.

Claims 1-7, 9, 12-18, and 20 are rejected under 35 U.S.C. 102(e) as being

anticipated by Arledge, Jr. et al. (US Patent 6,535,294-this reference was cited in Form

892 sent in the earlier Office action), hereinafter referred to Arledge.

7.1.   Regarding claims 1-3, Arledge discloses an information processing

apparatus capable of printing data by using another apparatus connected to a network

(see at least FIGs.1-3 and col.7, line 30-col.11, line 65. The wholesale web server 140

corresponds to an information processing apparatus capable of printing data by using

another apparatus, that is "280" the workflow management server computer connected

to a network.), comprising:

creating unit configured to create setting information to print data, during a

predetermined process of making a print data recognizable by the other apparatus in

accordance with a print instruction by a user (see at least Figs 1-3, col.10, lines 11-28

and col.15. line 55-col.16, line 43. Preparations system "201", see Fig.3 is the creating

means for creating setting information to print data and this print data is recognizable

by the other apparatus, that is "200" the workflow management server computer. The

predetermined process of making print data is disclosed in col.15, line 55-col.16, line

43 on the instructions of an end-user); and calculating unit configured to calculate a

print charge in accordance with the created setting information, wherein creating the

setting information and calculating the print charge are performed before the print data

is sent to the network (see at least, Fig.2, and col.17, lines 1-16, where the reference "

241" corresponds to the calculating means. The calculating means calculates the print

charge before it is sent to the network to "200" the workflow management server

computer for printing and displays the billing, that is printdata charges to the user to

enable him to decide to place or cancel the order). See col.8, line 63-col.11, line 65

and Figs. 2 and 3 which discloses that the calculating, and creating the setting

information are done by a control program, that "201-the information products

preparation system" for controlling the other apparatus, and further the programs which

create setting information and calculate price are different programs.).

Arledge also teaches that the web server computer 140 serves as a host

computer (see at least col.8, lines 47-62, "*The wholesaler web server computer 140 includes*

sufficient conventional hardware and software so as to enable the wholesaler web server computer

140 to "host" an Internet web site having a unique Internet web address on the World Wide Web

and using conventional protocols, such as http, to communicate therewith. ....").

Note: The limitations in the claim 1, " in accordance with a print instruction by an

operator of the information processing apparatus" indicates that how the claimed

creating unit is to be employed and does not limit the claimed invention in terms of

structure. Claims Directed to an Apparatus must be distinguished from the prior art in

terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582,

531 (CCPA 1959). A claim containing a " recitation with respect to the manner in which

a claimed apparatus is intended to be employed does not differentiate the claimed

apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural

limitations of the claim. Ex parte Masham, 2 USPQ2d 1657 (bd Pat. App. & Inter.

1987). Thus the structural limitations of claim 1, including a host computer, a creating

unit, and a calculating unit are disclosed in Arledge, as analyzed above. As per the

guidelines of the above cited court case, the limitation as how the creating unit is to be

employed does not distinguish the claimed apparatus from the prior art.

7.2.   Regarding claims 4-7, and 9, Arledge discloses the limitations of settling

beforehand before performing the calculation and sending the print data to the network,

the print data is not sent to the network if the charge exceeds a predetermined value,

notifying the user of print charges, for terminating a print process in response to an

operation by the buyer, calculates the print charge in accordance with charge

information stored in the information processing apparatus (see at least col.8, line 63-

col.10, line 28 and col.17, lines 1-16 which discloses that the charges for the

customized print data on the instructions of the user are calculated before sending the

print data to the network, that is the workflow management server for printing so that

the customer can accept or reject the charges and if the customer rejects the charges,

for the probable reasons that they exceed than his expectations then the print job is

terminated and the user is sent back to previous screen).

7.3.   Regarding claims 12-18, 20, and 23 there limitations are closely parallel to the

limitations of claims 1-7 and 9 and are therefore analyzed and rejected on the same

basis.

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 10 and 21 are rejected under 35 U.S.C. 103(a) as being obvious over

Arledge and further in view of an Official Notice.

8.1.   Regarding claim 10, Arledge discloses the information processing apparatus and

a program for calculating the print charges of the customized print data as per the

instructions of an user as analyzed above for claim 9. Arledge does not explicitly state

that the charge information is updated. However, the examiner takes an Official Notice

of the fact and benefits of updating any stored information for the obvious reason of

being able to know the prevailing rates for any job/services and submit the realistic

price quote/information to the buyer. In view of the Official Notice it would have been

obvious to one of an ordinary skilled in the art at the time of the applicant's invention to

have modified Arledge to incorporate the feature of updating the information related to

vendors, their bids, etc which is related to charge information for the print jobs because

it would enable the system to calculate the price bid for print jobs requested by the user

based on latest vendor prices rather than obsolete and old stored prices and avoid the

waste of time and money which will result by considering obsolete vendor data/prices.

8.2. Regarding claim 21 its limitations are closely parallel to the limitations of claim 10

and is therefore analyzed and rejected on the same basis.

Conclusion

9.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

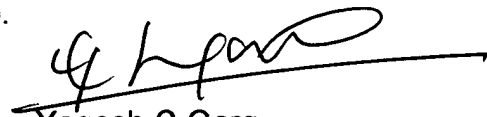policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-

6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
September 23, 2005